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EXAMINER

HALE, GLORIA M

ART UNIT PAPER NUMBER

3765

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

10/756,758

Applicant(s)

SMITH, R. SCOTT

Examiner

Gloria Hale

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Specification

The use of the trademark VELCRO has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

The disclosure is objected to because of the following informalities:

The specification must be updated to include all of the related applications under the heading "Related Applications" in the beginning of the specification and include their present status including Serial Number 10/197776 which is now abandoned; Serial Number 09/888,411 now Patent Number 6,592,428; Serial Number 09/440,937 which is now Patent Number 6,328,627 and Serial Number 09/229,303 which is now Patent Number 6,149,497.

Appropriate correction is required.

Claim Objections

Claims 15-17 are objected to because of the following informalities: In claims 15 and 16 there is no support for the "force distributor" as claimed in that it is not described as being of the claimed materials. It appears that what is actually being claimed is the "pressure distributor". Appropriate correction is required.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the tensioning apparatus as claimed in claims 1-8; the foundation garment, hook and loop fastener, fabric mesh and pocket as in claim 4; the adjusting part, drawstring and insert as being an inflatable bladder, pouch and belt as in claim 5 and the panty girdle structure as in claim 17 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claim 1, it is not clear as to what the term "tensioning apparatus" encompasses. The claims claim, and the specification also discloses, different embodiments, which are not structural equivalents. It is not clear as to which structure is actually being claimed. In claim 4 it is also not clear as to what is exactly being claimed. In claim 4 it is also not clear as to what is exactly being claimed since multiple embodiments have been claimed. There is also no antecedent basis for the term "force distributor". In claim 5 it is not clear as to how the "adjusting part" is structured or function. The claims are a listing of component parts and the relationship between the parts is not clear. In regard to claims 6-8 it is not clear as to how the pressure distributor pushes on the parasacral region with at least five times as much force than in the lumbar region especially when the claim refers back to claim 1 which states that the force is not in the lumbar region. If there is no force or zero force in the lumbar region as stated in claim 1, any multiple such, as five times, would also be zero. In regard to claims 4 and 5 the tradename VELCRO renders the claim indefinite. The tradename

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only identifies a source of material and not the material itself. Only the generic terminology should be used in the claims.

In regard to claims 1-20 the parasacral region and sacral region have not been positively recited with the proper antecedent basis. The structure which provides the pressure to the parasacral and sacral region without applying pressure to the lumbar region has not been clearly described in regard to the size or shape of the pressure distributor or as to how it functions to provide pressure at the locations as claimed with the pressure as claimed. The claims contain functional language, which does not clearly describe the structure of the invention. Many alternatives are given in the specification which are not structurally equivalent and it is not clear as to what exactly is being claimed, what the metes and bounds of the claims encompass or as to which structures provide the specific torr pressures. In regard to claim 4, line 2 a "force director" is claimed which does not have proper antecedent basis. In regard to claims 15 and 16 there is no antecedent basis for "the force distributor". Is it the "pressure distributor"? Also, in claim 15 it is not clear as to what the "laminate" includes or how the "metal" is compressible as claimed. In claim 17 it is not clear as to whether the parasacral region and sacral lumbar regions are of the wearer or the girdle. There is no antecedent basis for the "stiff portion" as claimed and it is not clear as to what the "stiff portion" is.

Also in claim 17 it is not clear if a "panty girdle" is being claimed in combination with the pressure distributor or if a pressure distributor itself is only being claimed. In claims 19 and 20 it is not clear if the claimed regions are of a "device" or of a "wearer". In claim

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20 there is no antecedent basis for "the middle" . It is also not clear as to in which axis the middle is being referred such as a horizontal middle or a vertical middle. In claim 18, lines 3-4 the recitation "is designed or modified for this purpose" renders the claim indefinite since it is not clear as to what is being claimed or as to what the "metes and bounds" of the claim language encompasses. The claim claims a "means for alleviating pelvic pain" yet no structure has been claimed other than a "tensioning apparatus". It is not clear as to how the tensioning apparatus performs the method of "continuously pressing the sacral and parasacral regions of a woman's back in addition to substantially avoiding the lumbar region. The claims are replete with indefinite language and are not clear and concise. However, the claims have been examined on their merits as best understood.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4-10,13,14 and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Mack (US 3,154,072).

Mack discloses a device including a pressure distributor (pad 12) and a tensioning apparatus (belt/adjustable strap 10), which presses into the sacral region. The pressure distributor and tension apparatus (the pad and belt device) inherently pushes on the sacral and parasacral regions when worn as claimed and not the lumbar region. (col. 1 ,lines 7-11). The pressure distributor presses in the parasacral region when worn as claimed in claims 5-10 in that when the lumbar region is not pressed on any pressure placed on the sacral and parasacral regions would be greater than that which is in the lumbar region. Also since the belt and pad do not directly place pressure on the lumbar area and more on the eparasacral and sacral areas the pressure would be greater in the latter areas. The device includes a thinner area (at 16) that straddles the sacral region.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 3, 11, 12, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mack (US 3,154,072).

In regard to claims 2, 3, 11 and 12 Mack discloses the invention substantially as claimed. However, Mack does not specifically disclose the specific torr pressures of 70 and 100 as claimed. The tightening of the belt provides the desired torr pressure. Accordingly, one of ordinary skill in the art at the time the invention was made would

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adjust the belt tension with the belt length adjusters and fastener to adjust the belt tension on the belt within the torr pressures as claimed. In regard to claims 15 and 16 Mack discloses the invention substantially as claimed. However, Mack does not specifically disclose the force distributor as being less than 3 cm or 5 cm thick. Mack does disclose the "force" or "pressure distributor" as being compressible foam. (See Col. 1, lines 41-42) Finding the specific thickness of the pad would be within one of ordinary skill in the art since finding the size or thickness of the pad would be within the skill of one of ordinary skill in the art dependent on the desired end use such as the size of the user in order to cover the sacral and parasacral areas and to be able to provide the force desired such as by providing a pad thickness of a thick enough amount depending on the size of the wearer wherein a larger person would need a larger and thicker pad.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eisen (US 3,071,133) in view of Waldmann (US 3,931,816).

Eisen discloses a support girdle with a pressure distributor (32) over the sacral and parasacral region that "substantially" avoids the lumbar region as broadly claimed since it only covers the junction area and a means for adjusting pressure (38) while the girdle is worn. However, Eisen does not specifically disclose the girdle as being a "panty girdle", which is known to be a girdle with a crotch and leg openings. Waldmann discloses such a panty girdle. Accordingly it would have been obvious to modify the girdle of Eisen with the teaching of Waldmann to include a crotch portion to provide

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protection and coverage in the wearer's crotch as desired so that an additional undergarment would not need to be worn with the Eisen girdle.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 of U.S. Patent No. 6,592,428; claims 1-9 of U.S. Patent No. 6,328,627 and claims 1-20 of U.S. Patent No. 6,149,497. Although the conflicting claims are not identical, they are not patentably distinct from each other because they claim a pressure distributor device and a tensioning apparatus in addition to a force distributor as claimed.

Conclusion


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited references disclose pressure distributor device for the sacral and parasacral body areas.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gloria Hale whose telephone number is 571-272-4984. The examiner can normally be reached on Tuesday-Friday.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Gloria Hale
Primary Examiner
Art Unit 3765
